

REMARKS

The foregoing Amendment and the following Remarks are submitted in response to the Office Action issued on April 6, 2005 in connection with the above-identified patent application, and are being filed within the three-month shortened statutory period set for a response by the Office Action.

Claims 1-3, 5, 8-14, 16, and 19-22 are pending in the present application. Independent claim 1 has been amended to include the subject matter of claims 4, 6, and 7, and such claims 4, 6, and 7 have thus been canceled. Likewise, independent claim 13 has been amended to include the subject matter of claims 15, 17, and 18, and such claims 15, 17, and 18 have thus been canceled. In addition, claims 5 and 16 have been amended to adjust dependencies, and claim 12 has been amended to address a minor issue. Applicant respectfully submits that no new matter has been added to the application by the Amendment.

Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims, consistent with the following remarks.

The Examiner has rejected claims 1-3, 5, 8-11, 13, 14, 16, and 19-21 under 35 USC § 102(b) as being anticipated by Sugayauchi et al. (U.S. Patent No. 6,238,005). Applicant respectfully traverses the § 102(b) rejection insofar as it may be applied to the claims as amended.

Independent claim 1 recites a wheel-balancing weight for being mounting to a wheel with a flange. The weight has a weighted body and a clip securely attached thereto. The body defines a recess therein, and the clip has a securing portion formed to be securely positioned within the recess defined in the body, as well as a grasping portion for securely grasping the flange. The recess of the body allows the clip to be positioned with respect to

such body so that the body is shifted toward the mounted-to wheel to achieve a proper fit to the wheel. That is, without the recess, the body would be farther away from the wheel and will not fit as well to such wheel. The securing portion of the clip is secured within the recess by flowing a portion of the body adjacent such clip into contact therewith.

In addition, claim 1 as amended recites that the body has an outboard face for facing away from the mounted-to wheel and an opposing inboard face for facing toward the mounted-to wheel, and the body defines the recess to extend along the inboard face. Also, the body has an inner radial face for facing toward an axis of the mounted-to wheel and an opposing outer radial face for facing away from the axis of the mounted-to wheel, and the body further defines the recess to transition from the inboard face and along the outer radial face. Finally, the securing portion of the clip includes a substantially planar radial portion positioned within the recess substantially parallel to the inboard face, and a substantially planar axial portion positioned within the recess substantially parallel to the outer radial face.

Independent claim 13 recites substantially the same subject matter as claim 1 although in the form of a vehicle having the wheel with the flange and the weight mounted to such flange.

In the prior art, and as was set forth in the background section of the present application, a wheel-balancing weight was typically constructed to have a body formed from lead or the like as a unitary mass around a steel clip, where the steel clip securely clips on to an exterior circumferential flange or lip at the rim of the wheel. However, the use of lead has come to be discouraged for environmental reasons , among others.

Accordingly, the body of the wheel-balancing weight is now formed from a material other than lead, such as for example steel or zinc. However, and as should be

appreciated, such steel or zinc weight cannot be easily formed as a unitary mass around the clip for the reason that the steel or zinc is less malleable than lead and has a higher melting point as compared to lead. Thus, the clip must be attached to the steel or zinc weight at a surface of such weight. Note, though, that merely attaching the clip to the weight at the surface thereof is not advisable if doing so causes the weight to be poorly positioned with respect to a wheel flange to which the weight is attached. Instead, and in the present invention, the body is provided with a recess that allows the body to be more properly positioned, both axially and radially, by having the recess appear at both axial (inboard) and radial (outer radial) faces of the body.

The Sugayauchi reference discloses several embodiments of a wheel-balancing weight with a body 1 having a recess 11 for securing a securing portion 31 of a clip 3. However, no Sugayauchi embodiment save that shown in connection with Fig. 12 is disclosed as having a recess 11 that at all appears at an outer radial face. Moreover, the Sugayauchi body 1 as shown in connection with Fig. 12 does not define the recess 11 thereof as transitioning from an inboard face (left side of body 1 in Fig. 12, e.g.) and along an outer radial face (top side of body 1 in Fig. 12), as is required by claims 1 and 13. At most, such recess 11 as shown in Fig. 12 transitions from the inboard face and then ends before reaching the outer radial face.

At any rate, and as shown in Fig. 14, the Sugayauchi clip 3 in connection with the body 1 shown in Fig. 12 does not have a securing portion 31 that includes a substantially planar radial portion positioned within the recess 11 substantially parallel to the inboard face and a substantially planar axial portion positioned within the recess substantially parallel to the outer radial face, as is required by claims 1 and 13. Instead, the Sugayauchi clip 3 of Fig.

14 never reaches a point where such securing portion 31 is substantially planar and axial and positioned within the Sugayauchi recess 11 substantially parallel to the outer radial face of the Sugayauchi body 1.

Thus, Applicant respectfully submits that the Sugayauchi reference does not disclose the subject matter recited in independent claims 1 and 13 or any claims depending therefrom. Accordingly, and for all the aforementioned reasons, Applicants respectfully submit that the Sugayauchi reference cannot be applied to anticipate such claims. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 102(b) rejection.

The Examiner has rejected claims 12 and 22 under 35 USC § 103(a) as being obvious over the Sugayauchi reference. Applicant respectfully traverses the § 103(a) rejection insofar as it may be applied to the claims as amended.

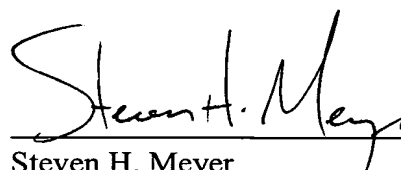
Applicant respectfully submits that since independent claims 1 and 13 have been shown to be unanticipated and are non-obvious, then so too must all claims depending therefrom including claims 12 and 22 be unanticipated and non-obvious, at least by their dependencies. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection.

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In view of the foregoing discussion, Applicant respectfully submits that the present application, including claims 1-3, 5, 8-13, 14, 16, and 19-22, is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Steven H. Meyer", is written over a horizontal line.

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